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09/656,320	09/06/2000	Douglas G. Delany		9073

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GROUP 3600

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 09/656,320
Filing Date: September 06, 2000
Appellant(s): DELANY ET AL.

Rochelle Lieberman
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 15 September 2006 appealing from the Office action

mailed 27 February 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings

which will directly affect or be directly affected by or have a bearing on the Board's decision in

the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in

the brief is incorrect. The application was rejected in a Final Office Action on 27 February 2006.

Appellant filed an Amendment After Final 27 April 2006, which raised new issues and

consideration, and consequently an Advisory action was mailed on 17 July 2006 indicating that

the After Final Amendment would not be entered. Appellant then submitted a second After Final

Amendment on 28 July 2006 to return the claims back to the form considered in the Final Office

Action however before this After Final Amendment was considered by the Examiner, Appellant

filed an Appeal Brief on 31 July 2006. Therefore the After Final submitted on 27 April 2006

was denied entry for new issues and consideration and the After Final Amendment submitted on

28 July 2006 was never considered because an Appeal Brief was filed thereafter. Therefore no

amendments after final have been entered.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

2001/0027449 A1   Wright   10-2001

Bates, M.E. "Dialog's DialUnits: A Price Increase in Sheep's Clothing" Searcher.

    Medford: vol. 6, iss. 8 (Sep 1998), pp. 56, 10 pgs.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

1.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2.   Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing

to particularly point out and distinctly claim the subject matter which applicant regards as the

invention.

    Regarding claim 1, the method for billing a user is unclear. Claim 1 recites that a fee is

first calculated based on an amount of time a user is logged on however it is unclear if this

calculation is sent to the user or considered in the billing. Further, claim 1 states the calculation

of an amount of usage and summing the calculated amount for each accessed function and later

multiplying by a usage point. However, there is no limitation where a price is calculated using

an amount of usage, the number of times a function is accessed and a usage point. Therefore,

claim 1 is rendered indefinite because it is unclear whether the billing of the user is from the

time-based calculation or from the amount of usage calculation. Further it is unclear the purpose

of two calculations if only one is utilized in billing.

Claim Rejections - 35 USC § 103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

4.   The text of those sections of Title 35, U.S. Code not included in this action can be found

in a prior Office action.

5.   The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148 USPQ 459

(1966), that are applied for establishing a background for determining obviousness under 35

U.S.C. 103(a) are summarized as follows:

1.   Determining the scope and contents of the prior art.
2.   Ascertaining the differences between the prior art and the claims at issue.
3.   Resolving the level of ordinary skill in the pertinent art.
4.   Considering objective evidence present in the application indicating obviousness
        or nonobviousness.

6.   Claims 1, 4-18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Wright U.S. Publication 2001/0027449 in view of Dialog's DialUnits: A Price Increase in

Sheep's Clothing (hereinafter Dialog).

Regarding independent claim 1, Wright discloses a computer-implemented method for

billing comprising: assigning a weight score to a webserver function, wherein said score is a

property of said function (page 2, paragraphs 0026 and 0028); identifying a user (page 2,

paragraph 0025); determining if said function has been accessed by the user (page 2, paragraphs

0025-0026 and page 3, paragraph 0034); identifying a number of uses of the function accessed in

response to said determination (page 4, claim 10); calculating an amount of usage by combining

the number of uses of the function accessed by the user with the weight assigned to the function

(page 4, claim 10); and billing said user for said calculated amount of usage (page 3, paragraph

0033-0035). Wright fails to teach that the weight score is assigned to the function prior to the

use of the function. Dialog teaches a computer implemented method for billing for a webserver

function in which DialUnits are used to represent usage of system resources (page 56, column 2).

A user is able to access the price list, which shows the various amounts DialUnits may cost (page

57, column 3 and page 59, Figure 1). Wright and Dialog shift the traditional cost scheme from a

time based system to a function based system, wherein Dialog incurs DialUnits for almost every

command, including DISPLAY SETS, COST, HELP and BEGIN (page 58, column 2). It would

have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to

modify the teachings of Wright and include having the weight score assigned prior to the

function so that users of the webserver function are able to have an understanding of the costs

they are about to incur. Further, knowing the cost functions prior to using the function, allows

the user to plan resource utilization and consequently refine techniques for use of the

functions/resource in an effort to minimize costs, as taught by Dialog with search techniques.

Claim 4 and 5, said step of determining required a webserver function log and a user log

file (page 2, paragraphs 0025-0026 and page 3, paragraph 0034),

Regarding independent claim 6, Wright discloses a computer-implemented method for

billing a user in a service provider environment comprising: a function weight assigned to a web-

server implemented function, , wherein said weight is a property of said function (page 2,

paragraphs 0026 and 0028); a user identification (page 2, paragraph 0025); function adapted to

be accessed by the user from a file (page 2, paragraphs 0025-0026 and page 3, paragraph 0034);

a manager adapted to track a number of uses of the function accessed by the user (page 4, claim

10); and a usage amount calculated by combining the number of uses tracked by said manager

with the weight assigned to the function (page 4, claim 10). Wright fails to teach that the weight

score is assigned to the function prior to the use of the function. Dialog teaches a computer

implemented method for billing for a webserver function in which DialUnits are used to

represent usage of system resources (page 56, column 2). A user is able to access the price list,

which shows the various amounts DialUnits may cost (page 57, column 3 and page 59, Figure 1).

Wright and Dialog shift the traditional cost scheme from a time based system to a function based

system, wherein Dialog incurs DialUnits for almost every command, including DISPLAY SETS,

COST, HELP and BEGIN (page 58, column 2). It would have been obvious to one of ordinary

skill in the art at the time of the Applicant's invention to modify the teachings of Wright and

include having the weight score assigned prior to the function so that users of the webserver

function are able to have an understanding of the costs they are about to incur. Further, knowing

the cost functions prior to using the function, allows the user to plan resource utilization and

consequently refine techniques for use of the functions/resource in an effort to minimize costs, as

taught by Dialog with search techniques.

Claim 7, wherein usage amount is determined by multiplying the number of uses of the

function by the weight assigned to that function (page 4, claim 10).

Claim 8, a total amount of usage for the user by summing a quantity of said usage amount

(page 2, paragraph 0027 and page 4, claim 10).

Claims 9 and 10, the file is a webserver function log and a user log file (page 2,

paragraphs 0025-0026 and page 3, paragraph 0034),

Regarding independent claim 11, Wright discloses an article for billing a user in a service

provider environment comprising a computer-readable signal bearing medium storing

instructions comprising: instructions for assigning a weight to a webserver implemented

function, (page 2, paragraphs 0026 and 0028); instructions for determining at least one function

that is accessed by the user from a file (page 2, paragraphs 0025-0026 and page 3, paragraph

0034); instructions for identifying the function accessed by the user responsive to said

determination instruction (page 4, claim 10); and instructions for calculating a usage amount by

combining the number of uses of said function by the weight assigned to that function (page 4, claim 10). Wright fails to teach that the weight score is assigned to the function prior to the use of the function. Dialog teaches a computer implemented method for billing for a webserver function in which DialUnits are used to represent usage of system resources (page 56, column 2). A user is able to access the price list, which shows the various amounts DialUnits may cost (page 57, column 3 and page 59, Figure 1). Wright and Dialog shift the traditional cost scheme from a time based system to a function based system, wherein Dialog incurs DialUnits for almost every command, including DISPLAY SETS, COST, HELP and BEGIN (page 58, column 2). It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Wright and include having the weight score assigned prior to the function so that users of the webserver function are able to have an understanding of the costs they are about to incur. Further, knowing the cost functions prior to using the function, allows the user to plan resource utilization and consequently refine techniques for use of the functions/resource in an effort to minimize costs, as taught by Dialog with search techniques.

Claim 12, wherein the instructions for calculating usage amount includes multiplying the number of uses of the function by the weight assigned to the function (page 4, claim 10).

Claim 13, instructions for determining a total amount of usage for the user by summing usage amount (page 2, paragraph 0027 and page 4, claim 10).

Claims 14 and 15, the file is a webserver function log and a user log file (page 2, paragraphs 0025-0026 and page 3, paragraph 0034),

Claim 16, the medium is a recordable data storage medium (page 1, paragraphs 0009-0011 and page 2, paragraph 0030 thru page 3, paragraph 0033 and Figure 1).

Claim 17, the medium is a modulated carrier signal (page 1, paragraphs 0009-0011 and page 2, paragraph 0030 thru page 3, paragraph 0033 and Figure 1).

Regarding 18 and 20, Applicant contests that Wright and Dialog fail to teach that the weight score is based on empirical data. Wright teaches that the rates are derived from a rating plan (page 2, paragraph 0028). Further Dialog teaches that DialUnits are designed to replicate the average cost for an average search of an average searcher. Therefore, both Wright and Dialog teach the use of empirical data for their rating/weight determinations and therefore Applicant's argument is not persuasive.

(10) Response to Argument

The Examiner summarizes the various points raised by the Appellant and addresses them individually.

A. Rejection of claims 1, 6 and 11 under 35 U.S.C. § 112

7.   Regarding claim 1, Appellant asserts that the After Final Amendment filed 28 July 2006

removed the language rendering claim 1 indefinite. However this amendment was never entered,

as discussed above, because an Appeal Brief was filed 3 days after on 31 July 2006.

8.   Appellant argues that even if the After Final Amendment was not allowed, that the

language of claim 1 of "calculating a fee based on an amount of time said user is logged" does

not render the claim indefinite because one of ordinary skill in the art would have understood

that the calculation is included in the billing (see Appeal Brief, pages 6-7).

In Response: This Examiner respectfully disagrees. Claim 1 performs two types of

calculations; one for the amount of time the user is logged as well as a calculations for each

function accessed by the user which are never summed together and appear to be mutually

exclusive. The calculation for each function accessed by the user includes multiple calculations

since there is a plurality of functions. This is supported by the fact that claim 1 actively sums the

calculated amount for each accessed function. However, claim 1 does not perform any

summation of the first calculation type (time logged) with the second calculation type (function).

Every step in claim 1 is drawn towards the process of calculating an amount for the function

(e.g., it is determined if a function is accessed, how many times its accessed, etc.). However,

there are no additional steps in claim 1 that support calculating the fee based on an amount of

time the user is logged (e.g. there is no logging on, no tracking of time). It is confusing whether

billing can be individually based on the calculation based on time logged or the calculation based

on functions accessed or the combination of both. Therefore, it would not be obvious to one of

ordinary skill in the art that the billing in claim 1 incorporates two different types of calculation

without incorporating significant assumptions into the language of claim 1 because the two types

of calculations are never summed together and appear to be mutually exclusive.

9.   Even if Appellant could argue successfully that one or ordinary skill in the art would

understand the calculation teachings of claim 1, it is worth pointing out that Wright teaches the

limitation of calculating a fee based on the time a user is logged on (page 2, paragraph 0026).

10.   The rejection of claims 6 and claim 11 under 35 U.S.C. § 112 is withdrawn because these

claims do not recite the step of billing the user which is needed in rendering the claim indefinite

as discussed with claim 1.

B. Rejection of claims 1, 6 and 11 under 35 U.S.C. § 103(a)

11.   Regarding claims 1, 6 and 11, Appellant asserts that Wright in view of Dialog fails to

teach *assigning a weight score to a webserver function, wherein said score is a property of said*

function and said weight score is assigned to said function prior to use of said function by a user

(see Appeal Brief, pages 8-15).

In Response: The Examiner respectfully disagrees and first directs The Board to the

teachings of Wright. Wright teaches instantaneous Internet charging. Wright teaches webserver

functions such as time, event and functions (page 2, paragraph 0026). Wright further teaches

assigning a weight score to one of these functions wherein the weight score is a property of said

function as recited in claim 1 in that Wright teaches that functions are rated based on rate per unit

measure which is derived from a rating plan (page 2, paragraph 0028). Wright teaches that the

webserver functions are predetermined (page 2, paragraph 0026). Wright is silent as to when the

rating plan is determined. Wright does teach that the billing application searches and retrieves

the rate plan for the services consumed (page 3, paragraph 0033) which suggests that the rating

plan is determined before the services are consumed. Nonetheless, even if the teachings of

Wright are not sufficient to provide the weight score prior to a user accessing such a function,

Dialog's teachings are. Dialog teaches a method of charging for internet service. Dialog teaches

webserver functions such as Display Sets, Cost, Help and Begin that incur costs through a

weighted measure called DialUnits (page 2, paragraph 11). Dialog teaches a price-list which can

be accessed prior to consumption and which shows how certain databases incur different

DialUnit charges (page 2, paragraph 4). Claims 6 and 11 contain similar limitation to claim 1

and are therefore rejected under the reasoning discussed above for claim 1.

Therefore it would have been obvious to one of ordinary skill in the art at the time of the

Appellant's invention to modify the teachings of Wright to include that the rate plan be assigned

prior to use of the function as taught by Dialog in the use of a price-list assigning DialUnits to

databases/functions because it provides pricing details to the consumer of the service so there is

an understanding of the pricing going into the billing of the services. Furthermore, both Wright

and Dialog are analogous art because one of ordinary skill in the art would understand them to be

in the same filed of art as the instant application for determining billing of a webserver function.

C. Rejection of claims 4, 5 and 18 under 35 U.S.C. § 103(a)

12.   Regarding claims 4, 5 and 18, Appellant asserts that Wright in view of Dialog fails to

teach the limitations of claims 4, 5 and 18 because they are dependent upon independent claim 1

(see Appeal Brief, pages 16-18).

In Response: Appellant has not provided separate arguments pointing out why dependent claims 4, 5, and 18 are patentable over Wright in view of Dialog and instead relies on their dependency to claim 1. Therefore claims 4, 5 and 18 stand or fall with the rejection of claim 1 discussed above.

D. Rejection of claims 7-10 under 35 U.S.C. § 103(a)

13.   Regarding claims 7-10, Appellant asserts that Wright in view of Dialog fails to teach the limitations of claims 7-10 because they are dependent upon independent claim 6 (see Appeal Brief, pages 18-20).

In Response: Appellant has not provided separate arguments pointing out why dependent claims 7-10 are patentable over Wright in view of Dialog and instead relies on their dependency to claim 6. Therefore claims 7-10 stand or fall with the rejection of claim 6 discussed above as being substantially similar to independent claim 1.

E. Rejection of claims 12-17 and 20 under 35 U.S.C. § 103(a)

14.   Regarding claims 12-17 and 20, Appellant asserts that Wright in view of Dialog fails to teach the limitations of claims 12-17 and 20 because they are dependent upon independent claim 11 (see Appeal Brief, pages 20-22).

In Response: Appellant has not provided separate arguments pointing out why dependent claims 12-17 and 20 are patentable over Wright in view of Dialog and instead relies on their dependency to claim 11. Therefore claims 12-17 and 20 stand or fall with the rejection of claim 11 discussed above as being substantially similar to independent claim 1.

G. Conclusion

15.   Appellants Appeal Brief regarding the rejections of claims 1, 4-18 and 20 has been

considered but it not persuasive as discussed above by the Examiner. The Examiner has

responded in full to Appellant's Appeal Brief to demonstrate that Wright in view of Dialog does

teach *assigning a weight score to a webserver function, wherein said score is a property of said*

function and said weight score is assigned to said function prior to use of said function by a user

wherein Wright and Dialog are analogous art with sufficient motivation to combine their

teachings.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related

Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,
Stefanos Karmis
Art Unit 3691
07 December 2006

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